

PATENT
Attorney Docket No. BOOSY-08803

REMARKS

Claims 1, 3-16 and 26 are pending, and Claims 10-16 are withdrawn. In the instant Final Office Action, the Examiner has raised a single new rejection:

- 1) Claims 1 and 3-9 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement.

Applicant hereby amends Claim 10 in order to further the prosecution of the present application and Applicant's business interests, yet without acquiescing to the Examiner's arguments.

Applicant reserves the right to prosecute the original, similar, or broader claims in one or more future application(s). In particular, Applicant has amended Claim 10 to depend upon Claim 1.

1) The Claims Are Enabled

The Examiner has rejected Claims 1 and 3-9 under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement. Specifically, the Examiner has posed numerous questions regarding the nature of the claimed invention. Applicant respectfully disagrees that the claims lack enablement, and hereby systematically addresses the questions posed by the Examiner in the instant Final Office Action (pages 2 and 3).

A. The Screen Supports The Tiles In A Vertical Plane While The Grid Holds The Tiles In A Horizontal Plane

The Examiner states that "Claim 1 recites that the screen is suitable for supporting said plurality of tiles however, page 7, line 21 states that the grid shown in Figure 1 is designed to hold square tiles. Which is it? Does the screen hold the tiles or does the grid hold the tiles?" Applicant respectfully draws the Examiner's attention to the description of the method for using the apparatus, which teaches that both the screen and the grid temporarily immobilize the mosaic tiles on all but the bottom surface of the tiles (e.g., for square tiles, the screen supports the top surface of the tiles while the grid holds or supports the four side surfaces of the tiles). Specifically, Applicant teaches that the

mosaic tiles are then placed into the grid 11 in the pattern chosen, if any, and in accordance with the underlying template, if any. The finished surfaces of the mosaic tiles are placed down into the grid and are registered with the specific surface (usually flat) under the grid. ... If the

PATENT
Attorney Docket No. BOOSY-08803

tiles were placed in the grid on a separate work surface, then the grid-mosaic tile assembly, is moved to the top of the screen at which time the design template and/or temporary support is slipped out from under the mosaic tiles without disturbing their placement in the grid (Specification, at page 9, lines 5-12).

Thus one skilled in the art would appreciate from the teaching of the application as filed, that the grid "holds" or "orders" the mosaic tiles in a horizontal plane, while the screen provides a "support" upon which the mosaic tiles rest in a vertical plane.

B. The Slots Are Voids In the Grid Through Which a Vacuum is Drawn Through Holes of the Screen

The Examiner asks "[w]hat is the nature of the 'slots' in the grid? [H]ow does the vacuum related to both the holes and the slots?" Applicant respectfully submits that the slots are simply "voids" in the grid within which mosaic tiles are placed in a desired relationship with one another (Specification, page 5, lines 12 and 13). As shown in Figures 2A-C for an exemplary embodiment comprising square mosaic tiles, the grid is a tool that can be used for arranging tiles in rows and columns. Without the grid element, the mosaic tiles are likely to shift during production of a mosaic sheet such that some tiles may become skewed leading to an irregular or disrupted pattern.

C. The Grid Is Held Together By Borders or Frames Surrounding The Plurality Of Slots Of The Grid

The Examiner states that "Figure 11 shows that grid 11 has a cross hatching pattern. What does that mean insofar as slots are concerned? If one manufactures cross hatched slots that extend completely through a sheet by a stamping process wouldn't that cause the whole grid plate to fall apart into little squares? Do slots extend from the top of the grid to the bottom of the grid so that vacuum passes through the slots? If so how does one make intersecting slots so that the material of the grid does not disassemble?" Applicant respectfully submits that the slots extend completely through the grid whose structural integrity is maintained by a series of borders surrounding the plurality of slots of the grid. Thus, although a stamping process used to create an exemplary grid would result in the production of a plurality of small squares (or in other embodiments, small circles, rectangles, etc.) the grid does not fall apart because the plurality of

PATENT
Attorney Docket No. **BOOSY-08803**

slots of the grid are separated by frames or borders such as that shown by lines in Figure 11 demarking tile rows and columns. Moreover as shown in Figures 2B and 2C, the lines or borders have a width corresponding to the mortar or grout space of the finished mosaic tile sheet. In particular, Applicant teaches that in some embodiments:

the grid is removed from the finished mosaic sheet comprising a plurality of tiles attached to a backing. The sheets are individually grouted immediately, or grouted with all other mosaic sheets and plain tiles collectively, at the time they are placed in their ultimate application (Specification, page 9, lines 27-30).

Thus, from the figures and Specification one skilled in the art would understand that the grid is held together by the small intersecting frames separating the slots in the grid and by the large frame surrounding the plurality of small frames and slots.

D. The Screen Comprises At Least One Hole Per Slot Of The Grid

The Examiner asks “[w]hat does it mean that the slots correspond to holes? Is this meant in a vacuum sense? Does vacuum passing through a hole also pass through a slot? Is there one slot for every hole?” Applicant also respectfully submits that one skilled in the art would appreciate from the Specification and the exemplary embodiment depicted in Figures 1A and 1B, that the claimed apparatus comprises at least one hole for every slot for channeling a negative pressure to a plurality of ordered mosaic tiles. In particular, Applicant teaches that a:

vacuum is applied to the top or finished surfaces of the mosaic tiles through the tank and screen, via a suitable pump 15 and tubing 14. This causes the individual mosaic tiles to register with the screen, which causes all finished faces of the mosaic to be leveled in the same place (or whatever curvature is desired and determined by the design of the screen and matching grid) regardless of what may be varying thicknesses of the different individual mosaic tiles (Specification, at page 9, lines 15-19).

E. Evidence As A Whole Indicates The Pending Claims Are Enabled

Applicant respectfully disagrees with the Examiner’s unsupported statement that the “disclosure cannot be understood so that one skilled in the art can make and use the device.” Applicant contends that when taken together the Specification and figures describing the actual reduction to practice of an exemplary embodiment of the claimed invention (e.g., working

PATENT
Attorney Docket No. **BOOSY-08803**

example) provide enabling support for the pending claims. In particular, Applicant has identified various locations in the application as filed to answer the questions posed by the Examiner regarding the pending claims directed to an apparatus and method for mosaic tile production (e.g., mechanical art). In contrast the Examiner has not provided any evidence to support his contention of likely skilled artisan confusion. The Examiner is respectfully reminded that he should never make an enablement determination on the basis of personal opinion, but rather on the weight of all the evidence (MPEP, 2164.05).

CONCLUSION

Applicant believes the arguments and amendments set forth above traverse the Examiner's rejection and, therefore requests that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect.

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By: 
Christine A. Lekutis
Registration No. 51,934

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
415.904.6500